

REMARKS

This reply is in response to the Office Action mailed on May 25, 2005 in which Claim 27 was withdrawn and in which Claim 1-26 and 28-37 were rejected. With this Reply, Claims 1-39 are attached. With this response, Claims 1, 4, 9, 11, 13, 15, 22, and 37 are amended and new Claims 38 and 39 are added. Reconsideration and allowance of Claims 1-26 and 28-39 are requested.

The Office Action further asserts that nail polish is merely considered a descriptive phrase defining the intended use of the device and is given no patentable weight.

I. Rejection of Claim 33 Under 35 U.S.C. § 112, first paragraph.

Paragraph 6 of the Office Action rejected Claim 33 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action stated that since the application does not appear to disclose “the depressment surface not extending radially outwardly beyond the housing,” Claim 33 contained subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Paragraph [0029] of the Specification states:

As further shown by FIGURE 1, housing 38 generally includes an enlarged portion 54, middle portion 56 and nose 58....

Paragraph [0031] of the Specification states:

As further shown by FIGURE 1, nose 58 has an outer surface that is generally flush with the outer surface of trigger 48 when trigger 48 is in the non-dispensing position. As a result the user may more comfortably grip and maintain a secure hold upon nose 58 while depressing or actuating trigger 48. Although less desirable, trigger 48 may alternatively extend above or partially below the surface of nose 58....

Since the specification discloses a housing 38 that includes a nose 58 outer surface that is generally flush with the outer surface of depressing or actuating

trigger 48, the Specification discloses “the depressment surface not extending radially outwardly beyond the housing” of Claim 33. Accordingly, the rejection of Claim 33 based upon 35 U.S.C. § 112 is improper and should be withdrawn.

II. Rejection of Claims 1-6, 10, 11, 14, 15, 17-20, 31, and 37 Under 35 U.S.C. § 102(b) Based Upon Gebauer ‘501.

Rejection of Claims 1-4, 6, 7, 15, 17, 19-21, 24-26, 28-30, 34, and 37 Under 35 U.S.C. § 102(b) Based Upon Beres ‘144.

Rejection of Claims 1-6, 10, 11-14, 15, 17-20, 31, 35, and 37 Under 35 U.S.C. § 102(b) Based Upon Gebauer ‘032.

Rejection of Claims 1, 3, 4, 6, 8, 10, 11, 14, 15, 19-20 Under 35 U.S.C. § 102(b) Based Upon Knight ‘252.

Rejection of Claims 1-4, 6, 10, 11, 14, 15, 17-21, 23, 31, 37 Under 35 U.S.C. § 102(b) Based Upon Gebauer ‘930.

Rejection of Claims 1, 3, 4, 6, 9, 15, 17-21, 28-30, 34, 36, and 37 Under 35 U.S.C. § 102(b) Based Upon Meshberg ‘222.

Paragraph 7 of the Office Action rejected Claims 1-6, 10, 11-14, 15, 17-20, 31, 35, and 37 under 35 U.S.C. § 102(b) as being anticipated by Gebauer, U.S. Patent No. 2,171,501 (hereinafter Gebauer ‘501). Paragraph 8 of the Office Action rejected Claims 1-4, 6, 7, 15, 17, 19-21, 24-26, 28-30, 34, and 37 under 35 U.S.C. § 102(b) as being anticipated by Beres et al., U.S. Patent No. 3,305,144 (hereinafter Beres ‘144). Paragraph 9 of the Office Action rejected Claims 1-6, 10, 11-14, 15, 17-20, 31, 35, and 37 under 35 U.S.C. § 102(b) as being anticipated by Gebauer, U.S. Patent No. 2,768,032 (hereinafter Gebauer ‘032). Paragraph 10 of the Office Action rejected Claims 1, 3, 4, 6, 8, 10, 11, 14, 15, 19-20, 28-30, 31, 32, 35, and 37 under 35 U.S.C. § 102(b) as being anticipated by Knight et al., U.S. Patent No. 3,306,252 (hereinafter Knight ‘252). Paragraph 11 of the Office Action rejected Claims 1-4, 6, 10, 11, 14, 15, 17-21, 23, 31, and 37 under 35 U.S.C. § 102(b) as being anticipated by Gebauer, U.S. Patent No. 2,313,930 (hereinafter Gebauer ‘930). Paragraph 12 of the Office Action rejected

Claims 1, 3, 4, 6, 9, 15, 17-21, 28-30, 34, 36, and 37 under 35 U.S.C. § 102(b) as being anticipated by Meshberg, U.S. Patent No. 2,914,222 (hereinafter Meshberg '222).

Independent Claims 1 and 37 overcome the rejections based upon Gebauer '501, Beres '144, Gebauer '032, Knight '252, Gebauer '930, and Meshberg '222. Those claims that depend from independent Claims 1 and 37 overcome the rejections for the same reasons which follow.

A. Claims 1 and 37.

Independent Claim 1 recites a nail polish applicator which includes a container extending along a longitudinal axis and a nail polish under pressure within the container.

Independent Claim 37 recites a nail polish applicator which includes a propellant container extending along a longitudinal axis and a nail polish under pressure within the container.

Neither Gebauer '501, Beres '144, Gebauer '032, Knight '252, Gebauer '930, nor Meshberg '222, alone or in combination, disclose or suggest a nail polish applicator which includes a nail polish under pressure within a container. The Office Action asserts that the devices of these patents are not prohibited from being used as a nail polish applicators. However, the Office Action misplaces the burden of proof requirement regarding anticipation and obviousness. The Office Action seems to assert that the Applicant has the burden of showing why the devices of the relevant prior art of record could not be used as a nail polish applicators. However, the law does not require the applicant to show that a prior art reference cannot be modified to meet a claim limitation. In contrast, it is the Examiner who must establish a prima facie case of obviousness. However, claims 1 and 37 positively recite a nail polish within the container.

Moreover, the Office Action has failed to establish a prima facie case of how or why one of ordinary skill in the art would use the dispensing receptacle of the prior art of record as nail polish applicators or would fill the receptacle of the prior art of record with nail polish under pressure. Gebauer '501, Beres '144, Gebauer '032, Knight '252, Gebauer '930, and

Meshberg '222, alone or in combination, fail to provide any motivation or suggestion for its use as a nail polish applicator or that it may alternatively be filled with nail polish.

Paragraphs 7 and 9 of the Office Action assert that:

Even if patentable weight was given to the intended use of the apparatus, to dispense nail polish, Gebauer discloses dispensing ethyl chloride, either alone or admixed with one or more other liquids (see page 1, lines 1-12). Ethyl chloride is a compound in nail polish. US Patent Number 4,646,765 to Cooper et al. is provided as evidence. Therefore, the ethyl chloride of Gebauer constitutes nail polish.

However, Ethyl Chloride is not a compound in nail polish and does not constitute nail polish. Cooper '765 is directed to "nail compositions containing cyanoacrylate and graphite" and "a method for forming an artificial human nail." Cooper '765 only discloses ethyl chloride as component in a liquid accelerator adapted to be applied to a base material by spraying it onto the base material in the form of a mist. The function of ethyl chloride as disclosed in Cooper '765 is to augment the liquid accelerator to further accelerate "the curing time of the matrix and enhance the dispersion of any heat generated" (col. 3, lines 23-26). Thus, at most, Cooper '765 merely discloses applying ethyl chloride to a base material (such as nail polish) that has already been applied to the nail by other means.

Moreover, Gebauer '501 actually teaches away from its use for dispensing nail polish. Gebauer '501 specifically states that "This invention relates to a dispensing receptacle for volatile liquids." (col. 1, lines 1-12). Volatile liquids are liquids which readily evaporate. Nail polish is not a volatile liquid. In addition, Gebauer '501 specifically states that the volatile liquid is to be capable of being "ejected under the force of its own vapor pressure." (col. 2, lines 50-51). Nail polish would seemingly produce an insufficient vapor for its ejection in the receptacle of Gebauer '501.

Paragraph 12 of the Office Action notes that "Meshberg discloses, in column 1, lines 45-50, dispensing cosmetics." However, it would not be obvious to dispense nail polish from the aerosol package of Meshberg '222. Traditional cosmetics dispensed from aerosol containers include hairspray and deodorant. Materials and applications such as hairspray and

deodorant are suited to the aerosol package of Meshberg '222 because they do not require precise manipulation of an applicator when dispensed. For this reason, aerosol packages such as those disclosed in Meshberg '222 do not commonly contain and dispense nail polish. It would not be obvious to dispense nail polish from the aerosol package of Meshberg '222.

Accordingly, Claims 1 and 37, as amended, overcome the rejection based upon Gebauer '501, Beres '144, Gebauer '032, Knight '252, Gebauer '930, and Meshberg '222. Claims 2-36 and 39, which depend from Claim 1, and Claim 38, which depends from Claim 37, also overcome the rejection based upon Gebauer '501, Beres '144, Gebauer '032, Knight '252, Gebauer '930, and Meshberg '222 for the same reasons.

B. Claim 4.

Dependent Claim 4, as amended, recites the applicator of Claim 2 wherein the applicator includes a housing at least partially about the container, wherein the housing extends at least a majority of the length of the container along the longitudinal axis. Since dependent Claim 4 depends from dependent Claim 2, which depends from independent Claim 1, Claim 4 overcomes the prior art of record for the same reasons addressed above. Dependent Claim 4 recites additional features which are also patentably distinct from the prior art of record.

Neither Gebauer 501, Beres 144, Gebauer 032, Knight '252, Gebauer '930, nor Meshberg '222, alone or in combination, disclose a "nail polish applicator" having a nail polish under pressure within a container, a nozzle rigidly coupled to the container, a nozzle substantially sharing a longitudinal axis with the longitudinal axis of the container, an actuator including a trigger movable in a direction towards the longitudinal axis of the container, and a housing at least partially about the container, wherein the housing extends at least a majority of the length of the container along the longitudinal axis.

In contrast, Gebauer 501, Beres 144, Gebauer 032, Knight '252, and Gebauer '930 disclose structures which the Office Action characterized as housings that only screw or connect to the very top of the container, not acting as a housing and only covering a small minority of the length of the container. None of the structures in Gebauer 501, Beres 144,

Gebauer 032, Knight '252, and Gebauer '930 that the Office Action characterizes as housings are specifically disclosed as being a "housing." For example, paragraph 7 of the Office Action characterized Gebauer '501, reference numbers 13 and 35, as "a housing." However, Gebauer '501 does not contain reference number 35 and reference number 13 is described as a "central bore" which extends through the neck of the receptacle.

Applicants note that the Office Action characterized reference number 39 of Meshberg '501 as an actuator. Meshberg '501, reference number 39, is specifically disclosed as being a "fixed member 39 having a bore 39a and a dispensing passage 39b mounted within the nozzle and communicating with a discharge aperture 38a in the nozzle." It would not be obvious to modify the fixed member 39 to become an actuator including a trigger movable in a direction towards the longitudinal axis of the container. Accordingly, dependent Claim 4, as amended, overcomes the rejections based upon Gebauer 501, Beres 144, Gebauer 032, Knight '252, Gebauer '930, and Meshberg '222. Those claims that depend from Claim 4 also overcome the rejection based upon Gebauer 501, Beres 144, Gebauer 032, Knight '252, Gebauer '930, and Meshberg '222.

C. Claim 15.

Dependent Claim 15 depends from independent Claim 1 and overcomes the prior art of record for the same reasons addressed above. Dependent Claim 15 also claims additional features which are patentably distinct from the prior art of record. Dependent Claim 15, as amended, recites the applicator of Claim 1, wherein the container has an outer surface configured to be manipulated in a manner similar to that of a pen between a thumb, a middle finger, and an index finger, and wherein the index finger may easily engage the actuator when manipulating the outer surface in the pen-like manner.

Neither Gebauer '501, Beres '144, Gebauer '032, Knight '252, Gebauer '930, nor Meshberg '222, alone or in combination, disclose a container having an outer surface configured to be manipulated in a manner similar to that of a pen between a thumb, a middle finger, and an index finger, and wherein the index finger may easily engage the actuator when manipulating the outer surface in the pen-like manner. In contrast, the prior art of record

discloses container structures and shapes not designed to be held in a pen-like manner. For example, in Gebauer '501, Figure 1 displays what appears to be a large bulbous receptacle 10 including a cap element 12 which appears to be substantially larger than nozzle 19.

Additionally, the lever 18 appears to project away from the nozzle 19. The relative size and orientation of the structures of Gebauer '501 appear to restrict the dispensing receptacle of Gebauer '501 from being manipulated in a manner similar to that of a pen between a thumb, a middle finger, and an index finger wherein the index finger may easily engage the actuator when manipulating the outer surface in a pen-like manner. Accordingly, dependent Claim 15, as amended, overcomes the rejection based upon Gebauer '501, Beres '144, Gebauer '032, Knight '252, Gebauer '930, and Meshberg '222.

III. Rejection of Claim 5 Under 35 U.S.C. § 102(b) Based Upon Gebauer '501.

Rejection of Claim 5 Under 35 U.S.C. § 102(b) Based Upon Gebauer '032.

Paragraph 7 of the Office Action rejected Claim 5 under 35 U.S.C. § 102(b) as being anticipated by Gebauer '501. Paragraph 9 of the Office Action rejected Claim 5 under 35 U.S.C. § 102(b) as being anticipated by Gebauer '032. Claim 5 depends from Claim 4 and overcomes the rejection based on Gebauer '501 and Gebauer '032 for the same reasons discussed above with respect to the rejection of Claim 4.

However, with respect to the rejection of Claim 5, Applicants note that Claim 5 recites a housing of Claim 4, wherein the housing includes a plurality of sections fastened together about the container. Neither Gebauer '501 nor Gebauer '032, alone or in combination, disclose a housing including a plurality of sections fastened together about the container. In contrast, Gebauer '501 discloses a central bore 13 (which is characterized in the Office Action as a housing) which appears to resemble a hollow chamber. Because Gebauer '501 specifically discloses structure 13 as a central bore, it would not be obvious to transform central bore 13 of Gebauer '501 into a housing of Claim 5 including a plurality of sections fastened together about the container.

Gebauer '032 also fails to disclose a housing including a plurality of sections fastened together about the container. Gebauer '032 discloses a cap 5 (which is characterized in the

Office Action as a housing) which is received by an external thread of neck 2 of glass bottle

1. Cap 5 does not appear to be a housing including a plurality of sections fastened together about a container. It would not be obvious to transform cap 5 of Gebauer '032 into a housing of Claim 5 including a plurality of sections fastened together about the container.

Accordingly, Claim 5 overcomes the rejection based on Gebauer '501 and '032.

IV. Rejection of Claim 8 Under 35 U.S.C. § 102(b) Based Upon Knight '252.

Paragraph 10 of the Office Action rejected Claim 8 under 35 U.S.C. § 102(b) as being anticipated by Knight '252. Claim 8 depends from Claim 4 and overcomes the rejection based on Knight '252 for the same reasons discussed above with respect to the rejection of Claim 4.

Additionally, with respect to Claim 8, Applicants note that Claim 8 recites a housing having a first exterior surface and wherein the actuator includes a trigger having a depressment surface substantially flush with the outer surface of the housing. Knight '252 fails to disclose an actuator including a trigger having a depressment surface. In contrast, Knight '252 discloses a finger grip 19 (characterized by the Office Action as an actuator) which does not appear to be substantially flush with any surface. Moreover, neither the trigger structure of Claim 8 nor the housing of Claim 8 is disclosed in Knight '252. Therefore, it would not be obvious to reposition finger grip 19 (characterized by the Office Action as an actuator) to be substantially flush with the outer surface of the housing. Accordingly, Claim 8 overcomes the rejection based on Knight '252.

V. Rejection of Claim 9 Under 35 U.S.C. § 102(b) Based Upon Meshberg '222.

Paragraph 12 of the Office Action rejected Claim 9 under 35 U.S.C. § 102(b) as being anticipated by Meshberg '222. Claim 9 depends from Claim 4 and overcomes the rejection based upon Meshberg '222 for the same reasons discussed above with respect to the rejection based upon Meshberg '222 in paragraph 12 of the Office Action.

Applicants note that Claim 9, as amended, recites the housing of Claim 4 wherein the housing has a longitudinal length greater than the container, and wherein the housing abuts

and completely covers an axial end of the container opposite the nozzle, and wherein the container remains stationary inside the housing when actuated. Meshberg '222 discloses an aerosol package wherein the bottom of container 15 is left partially uncovered such that spray is actuated by pushing up on the bottom of the exposed container with a finger or with a removable closure 66. The container slides relative to the housing when the aerosol package of Meshberg '222 is actuated. Thus, since Meshberg '222 neither discloses a housing which completely covers the axial end of the container opposite the nozzle, nor discloses a nail polish applicator wherein the container remains stationary inside the housing when actuated, Claim 9 recites additional patentable features over the prior art of record. Accordingly, the rejection of Claim 9 based upon Meshberg '222 is improper and should be withdrawn.

VI. Rejection of Claim 11 Under 35 U.S.C. § 102(b) Based Upon Gebauer '501.

Rejection of Claims 11-13 Under 35 U.S.C. § 102(b) Based Upon Gebauer '032.

Rejection of Claims 11 Under 35 U.S.C. § 102(b) Based Upon Knight '252.

Paragraph 7 of the Office Action rejected Claim 11 under 35 U.S.C. § 102(b) as being anticipated by Gebauer '501. Paragraph 9 of the Office Action rejected Claims 11-13 under 35 U.S.C. § 102(b) as being anticipated by Gebauer '032. Paragraph 10 of the Office Action rejected Claim 11 under 35 U.S.C. § 102(b) as being anticipated by Knight '252. Claims 11-13 depend from Claim 1 and overcome the rejection based on Gebauer '501, Gebauer '032, and Knight '252 for the same reasons discussed above with respect to the rejection of Claim 1. Claim 11 recites a cap configured to removably cover the nozzle. Claim 12 recites a cap configured to removably cover the trigger. Claim 13 recites the cap of Claim 12, wherein the cap also removably covers the nozzle. Paragraph [0032] of the Specification discloses "cap 60 which receives nose 58 to cover outlet 42". FIGS. 1-3 and 12 also display cap 60 covering outlet 42.

Neither Gebauer '501, Gebauer '032, nor Knight '252, alone or in combination, disclose a cap which covers the outlet. In contrast, Gebauer '501 discloses a cap from which a boss 14 projects upwardly. The boss 14 receives a nozzle element 19 containing capillary

opening 21. The nozzle, nozzle opening, and trigger of Gebauer '501 extend or project from the cap of Gebauer '501, rather than removably cover these structures.

The Office Action characterized attachment 25 of Gebauer '032 as a cap. Gebauer '032 describes attachment 25 as an attachment that "consists of a frusto-conical tubular body having an avail cylindrical bore 26 and a side opening 27 that extends the full length of the body" (col. 3, lines 16-19). Figure 3 of Gebauer '032 displays the attachment 25 as having an open bore 26 that directs the spray of the lubricant dispenser of Gebauer '032. Attachment structure 25 of Gebauer '032 does not removably cover the nozzle or the trigger.

The Office Action characterized the outer section 14 of Knight '252 as a cap. Knight describes section 14 as helping to define a circular spray opening 16. The section 14 of Knight '252 does not removably cover the nozzle 43. Accordingly, dependent Claims 11-13 overcome the rejections based upon Gebauer '501, Gebauer '032, and Knight '252.

VII. Rejection of Claim 21 Under 35 U.S.C. § 102(b) Based Upon Beres '144.

Rejection of Claim 21 Under 35 U.S.C. § 102(b) Based Upon Meshberg '222.

Paragraphs 7 and 12 of the Office Action state that the aerosol containers of Beres '144 and Meshberg '222 inherently have a dip tube. Neither Beres '144 nor Meshberg '222 disclose a dip tube. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Office Action does not provide a basis in fact or technical reasoning to support the determination that a dip tube necessarily flows from the aerosol containers of Beres '144 and Meshberg '222. If a propellant gas or liquid also comprises the deliverable material of the aerosol can, a aerosol can does not need a dip tube. In this situation, the actuation of the valve in the absence of a dip tube would still result in the expulsion of material from the aerosol container. Since a dip tube does not necessarily flow from the teaching of the aerosol

containers of Beres '144 or Meshberg '222, the rejection of claim 21 is improper. Applicants respectfully request reconsideration.

VIII. Rejection of Claim 16 Under 35 U.S.C. § 103(a) Based Upon Gebauer '501.

Paragraph 13 of the Office Action rejected Claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Gebauer '501. For the reasons which follow, Applicants respectfully request that the rejection of Claim 16 be withdrawn.

Paragraph 13 of the Office Action stated:

Regarding claim 16, Gebauer discloses the limitations of the claimed invention with the exception of the diameter of the container proximate the actuator. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have limited the container outer diameter proximate the actuator to not greater than 1.0 inch, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Gebauer '501 is directed to a "dispensing receptacle" and discloses a receptacle 10 and a closure 11, wherein the closure 11 is operatively connected to a nozzle element 19 and a level 18.

Claim 16, as amended, recites a "nail polish applicator" of Claim 1, comprising, in combination with the other elements of Claim 1, wherein "the container has a maximum outer diameter of 1.0 inch proximate the actuator."

The "nail polish applicator" recited in dependent Claim 16 would not have been obvious in view of Gebauer '501. First, Gebauer '501 does not disclose, teach or suggest a "nail polish applicator" of Claim 1, for the reasons discussed above. Second, Gebauer '501 does not disclose, teach or suggest the additional patentable elements of Claim 16, wherein the container has a maximum outer diameter of 1.0 inch proximate the actuator. Gebauer '501 fails to provide any motivation or suggestion for the modification which would result in the container having a maximum outer diameter of 1 inch proximate the actuator. Applicants' disclosure describes these claim features as enabling a user to more closely

position his or her fingers to the outlet so as to enable greater control and precision when applying nail polish to the nail. In contrast, Gebauer '501 describes a “dispensing receptacle” which “affords a convenient means of delivering a predetermined bulk and one which may be varied by the simple expedient of placing a different quantity of the fibrous material in the cavity.” (col. 2, lines 14-17). Given the use taught by Gebauer '501, one of ordinary skill in the art would not be lead to modify Gebauer '501 such that the container has a maximum outer diameter of 1 inch proximate the actuator.

To transform the “dispensing receptacle” of Gebauer '501 into a “nail polish applicator” as recited in Claim 16 would require modification that is only taught by the Applicants’ own disclosure. The suggestion to make the transformation of Gebauer '501 into the “nail polish applicator” of Claim 16 has been taken from Applicants’ own specification (using hindsight), which is improper.

The “nail polish applicator” recited in dependent Claim 13 would not have been obvious is view of Gebauer '501. The rejection of Gebauer '501 under 35 U.S.C. § 103(a) is improper. Therefore, dependent Claim 16 is patentable over Gebauer '501.

IX. Rejection of Claims 1-4, 6, 7, 15, 17, 19, 20, 21, 24, 25, 26, 28, 29, 30, 34, and 37 Under 35 U.S.C. § 103(a) Based Upon Ellis '734 in view of Beres '144.

Paragraph 14 of the Office Action rejected Claims 1-4, 6, 7, 15, 17, 19, 20, 21, 24, 25, 26, 28, 29, 30, 34, and 37 under 35 U.S.C. § 103(a) based upon Ellis el al. '734 in view of Beres '144. For the reasons which follow, Applicants respectfully request that the rejection of Claims 1-4, 6, 7, 15, 17, 19, 20, 21, 24, 25, 26, 28, 29, 30, 34, and 37 be withdrawn.

Paragraph 7 of the Office Action stated that:

Ellis discloses dispensing a nail polish using a pressurized can 12.

The Office Action further stated that:

Beres discloses an applicator comprising: a container 10; a nozzle 26; an actuator 70; a housing 58, 64; an aerosol valve 14. Regarding claim 21, the aerosol container 10 of Beres inherently has a dip tube.

The Office Action concluded that:

It would have been obvious to a person having ordinary skill in the art at the time of invention to have used the device of Beres to spray nail polish of Ellis for mobility and manipulation of the nozzle without moving the container (Beres, column 2, lines 15-31).

Ellis '734 is directed to "fingernail coating device" and discloses a fingernail sprayer 10 adapted for mounting on a pressurized can of polish, where the body portion 14 of sprayer 10 guides spray from can nozzle 30 to spray nozzle 16 and subsequently a stencil end 18.

Beres is directed to a "dispenser for disposable aerosol container, with valved conduit for remote discharge of its contents" and discloses a nozzle unit 26 operatively connected via a tube 24 to adapter 18 which further operatively connects to container 10. (see Beres '144, col. 1, line 72 – col. 2, line 15).

Claim 1 is in independent form and, as amended, recites a "nail polish applicator" comprising, in combination with other elements, "a nozzle rigidly coupled to the container and having an outlet opening" and "wherein the nozzle has a longitudinal axis, wherein the outlet opening lies substantially along the longitudinal axis, the longitudinal axis of the nozzle being substantially parallel or coextensive with the longitudinal axis of the container."

Claim 37 is in independent form and, as amended, recites a "nail polish applicator" comprising, in combination with other elements, "a nozzle fixedly secured adjacent to the container" and wherein "the nozzle is configured to dispense the nail polish along a dispensing axis substantially parallel or coextensive with the longitudinal axis of container; and a housing at least partially about the container extending along the longitudinal axis of the container at least the majority of the length of the container, wherein the housing has a frusto-conical nose proximate the nozzle." Claims 2-36 and 39 depend from independent Claim 1 and Claim 38 depends from independent Claim 37.

The "nail polish applicator" recited in independent Claim 1 and 37 would not have been obvious in view of Ellis '734, alone or in any proper combination with Beres under 35 U.S.C. § 103(a). Ellis '734, alone or in any proper combination with Beres, does not disclose, teach or suggest a "nail polish applicator" comprising, in combination with other

elements, “a nozzle rigidly coupled to the container and having an outlet opening” and “wherein the nozzle has a longitudinal axis, wherein the outlet opening lies substantially along the longitudinal axis, the longitudinal axis of the nozzle being substantially parallel or coextensive with the longitudinal axis of the container.”

To transform the “fingernail coating device” of Ellis ‘734 and the “dispenser for disposable aerosol container, with valved conduit for remote discharge of its contents” of Beres into a “nail polish applicator” as recited in Claims 1 and 37 would require still further modification, and such modification is taught only by the Applicants’ own disclosure. The suggestion to make the combination of Ellis ‘734 and Beres has been taken from the Applicants’ own specification (using hindsight), which is improper.

The “nail polish applicator” recited in independent Claims 1 and 37, as considered as a whole, would not have been obvious in view of Ellis ‘734 and/or Beres. The rejection of Claim 1 over Ellis ‘734 and/or Beres under 35 U.S.C. § 103(a) is improper. Therefore, independent Claims 1 and 37 are patentable over Ellis ‘734 in view of Beres. Dependent Claims 2-36 and 39, which depend from independent Claim 1, and dependent Claim 38, which depends from independent Claim 37, are also patentable. See 35 U.S.C. § 112 ¶ 4.

X. Rejection of Claim 22 Under 35 U.S.C. § 103(a) Based Upon Meshberg ‘222 in view of Fulton ‘680.

Paragraph 15 of the Office Action rejected Claim 22 under 35 U.S.C. § 103(a) based upon Meshberg ‘222 in view of Fulton ‘680. For the reasons which follow, Applicants respectfully request that the rejection of Claim 22 be withdrawn.

Paragraph 15 of the Office Action stated:

Meshberg discloses the limitations of the claimed invention with the exception of the dip tube extending proximate to the side surface of the container.

Paragraph 15 of the Office Action further stated:

Fulton discloses a tube 14 extending proximate to the side surface of container 11.

Paragraph 15 of the Office Action concluded that:

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided a flexible dip tube of Fulton to the device of Meshberg to dispense the container in various orientations.

Meshberg '222 is directed to an "aerosol package" and provides a housing "with means whereby finger pressure can be applied to the container to cause the container and fixed member on the housing to be moved toward one another to actuate the valve in the container and cause the fluid in the container to be dispensed therefrom through the nozzle for the package." (col. 1, lines 29-34).

Fulton '680 is directed to a "dispenser for pressurized products" and discloses a "dispensing device comprising a flexible, non-kinking eduction tube 14." (col. 3, lines 30-37). The eduction tube 14 of Fulton '680 is designed to orient itself in a variable manner depending on the position of the dispenser (see Fulton '680, figs. 1 and 2).

The Office Action first asserted that Meshberg '222 discloses the limitations of the claimed invention except the dip tube. However, as discussed above, Claim 1 overcomes rejections based on Meshberg '222 for the reasons stated above.

Claim 22 depends from dependent Claim 21 and, as amended, recites the applicator of Claim 21, "wherein the container has an interior side surface extending along the longitudinal axis of the container and wherein the tube permanently extends proximate to the side surface." By permanently extending proximate to the side surface of the interior longitudinal side surface of the container, the dip tube of Claim 22 is inflexible so as to retain its proximity to the side surface when the container is manipulated in any direction.

The "nail polish applicator" recited in Claim 22 would not have been obvious in view of Meshberg '222, alone or in any proper combination with Fulton '680 under 35 U.S.C. § 103(a). Meshberg '222, alone or in any proper combination with Fulton, neither discloses, teaches or suggests a "nail polish applicator" comprising, in combination with other elements, a container which "has an interior side surface extending along the longitudinal axis of the container and wherein the tube permanently extends proximate to the side surface."

To transform the “aerosol package” of Meshberg ‘222 and the “dispenser for pressurized products” of Fulton ‘680 into a “nail polish applicator” as recited in Claim 22 would require still further modification, and such modification is taught only by the Applicant’s own disclosure. The suggestion to make the combination of Meshberg and Fulton has been taken from the Applicant’s own specification (using hindsight), which is improper.

The “nail polish applicator” recited in dependent Claim 22, as considered as a whole, would not have been obvious in view of Meshberg and/or Fulton. The rejection of Claim 22 over Meshberg and/or Fulton under 35 U.S.C. § 103(a) is improper. Therefore, Claim 22 is patentable over Meshberg in view of Fulton.

XI. Added Claims.

With this Reply, Claims 38-39 are added. Added Claims 38-39 are believed to be patentably distinct over the prior art of record. Applicant respectfully requests consideration and allowance of new Claims 38-39.

Added Claim 38 ultimately depends from independent Claim 37 and is patentably distinct over the prior art of record for the same reasons discussed above with respect to the previous rejection of Claim 37. Added Claim 38 recites additional features which also patentably distinguish the “nail polish applicator” of Claim 38 over the prior art of record. The prior art of record fails to disclose, teach or suggest the applicator of Claim 37 wherein the housing further comprises a first portion distant the nozzle configured to rest against the snuff box of a human hand, and a second portion near the nozzle configured to be contacted by and between a middle finger of the human hand, wherein the housing and actuator are further configured such that an index finger of the human hand may rest on and engage the actuator.

Added Claim 39 ultimately depends from independent Claim 1 and is patentably distinct over the prior art of record for the same reasons discussed above with respect to the previous rejection of Claim 1. Added Claim 39 recites additional features which also patentably distinguish the “nail polish applicator” of Claim 39 over the prior art of record.

The prior art of record fails to disclose, teach or suggest the applicator of Claim 1 wherein the housing further comprises a first portion distant the nozzle configured to rest against the snuff box of a human hand, and a second portion near the nozzle configured to be contacted by and between a middle finger of the human hand, wherein the housing and actuator are further configured such that an index finger of the human hand may rest on and engage the actuator.

XII. Conclusion.

After amending the claims as set forth above, claims 1-26 and 28-39 are now pending in this application.

Because the rejections of dependent claims 2-26 and 28-36 are overcome by their respective independent claims, additional comments regarding the basis of the rejection of the dependent claims would be moot. The lack of additional comments regarding the characterizations made in the Office Action regarding the prior art and such dependent claims should in no way be treated as an admission or an acknowledgment by Applicants that such characterizations are necessarily proper or accurate.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date August 25, 2005 By Todd A. Rathe

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5710
Facsimile: (414) 297-4900

Todd A. Rathe
Attorney for Applicant
Registration No. 38,276